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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/051,827 05/01/98 ZIMMERMANN

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EXAMINER

BERCH, M

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

05/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/051,827

Applicant(s)
Zimmermann

Examiner
Mark L. Berch

Group Art Unit
1624



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

This action is Supplemental to the previous action. All aspects of the previous rejection are repeated. In addition:

A. Add the following item to the 35 USC 112, paragraph 2 rejection:

12. Claims 15-16 are improperly dependent on claim 1 as they fail to further limit.

These claims set forth materials not present in claim 1.

B. Add the following two art rejections:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 5-15 are rejected under 35 U.S.C. 102(a) as being anticipated by Mackman.

Note the indicated species in column 16, which anticipate the claims for the 9-substituted isomers. The synthesis is shown at the top of column 15. The utility is the same. Antedating the reference will require showing that the claims are entitled to the 11/1/1995 Swiss priority date; no certified translation has been provided.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackman.

Claim 4 differs in three respects from the 3-bromoanilino species at Column 16, line 33:

1. R_4 is H. However that feature (R_4 also in the reference) is seen in the reference at column 4, line 16. Examples of species with just the secondary amino in the 2-position are seen in Table 1, e.g. Table 1, sixth species.
2. Claim 4 has Cl, the species has Br. But the generic formula teaches halo, and the halogens ordinarily suggest each other anyway. Alternatively, the species as column 16, line 52 has a 3-Cl, albeit with also 4-Cl, but that would suggest Cl as well.
3. Claim 4 has 9-ethyl; the species has 9-propyl. But lower alkyl is taught generically, and ethyl is taught specifically at column 4, line 45. Also, compounds that differ only by the presence or absence of an extra methyl group or two are homologues. Homologues are of such close structural similarity that the disclosure of a compound renders *prima facie* obvious its homologue. The homologue is expected to be preparable by the same method and to have generally the same properties. This expectation is then deemed the motivation for preparing homologues. Of course,

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these presumptions are rebuttable by the showing of unexpected effects, but initially, the homologues are obvious even in the absence of a specific teaching to add or remove methyl groups. See *In re Wood*, 199 USPQ 137; *In re Hoke*, 195 USPQ 148; *In re Lohr*, 137 USPQ 548; *In re Magerlein*, 202 USPQ 473; *In re Wiechert*, 152 USPQ 249; *Ex parte Henkel*, 130 USPQ 474; *In re Fauque*, 121 USPQ 425; *In re Druey*, 138 USPQ 39. In all of these cases, the close structural similarity between two compounds differing by one or two methyl groups was itself sufficient show obviousness. See also MPEP 2144.09, second paragraph.

With regard to claim 3, only factor 1 applies.

Burns is cited for the starting material of Example 33 but does not render the claims obvious.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718.

A handwritten signature in black ink, appearing to read "Mark L. Berch". The signature is fluid and cursive, with the first name "Mark" and last name "Berch" clearly distinguishable.

Mark L. Berch

Primary Examiner

Group 1610 - Art Unit 1624

April 26, 2000